<u>REMARKS/ARGUMENTS</u>

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 9-47 are pending in this application. Claims 23 and 47 are amended by the present amendment. No new matter is added.

In the outstanding Official Action, the specification and claims were objected to; Claims 9, 11, 14, 16, 23, 32, 33, 41, 46, and 47 were rejected under 35 U.S.C. §112, second paragraph; Claims 23, 33, and 41-47 were rejected under 35 U.S.C. §102(a) as anticipated by Kenji (Japanese Patent No. 09-081416); Claims 17-22 were rejected under 35 U.S.C. §102(e) as unpatentable over Harrison (U.S. Patent No. 6,421,071); Claims 9-14 and 16 were rejected under 35 U.S.C. §103(a) as unpatentable over Kenji in view of Kunio (Japanese Patent No. 09-006702) and further in view of Nakamura (U.S. Patent No. 6,381,565); Claim 15 was rejected under 35 U.S.C. §103(a) as unpatentable over Kenji in view of Kunio and further in view of Grey et al. (U.S. Patent No. 6,401,220, herein "Grey"); and Claims 24-32 and 34-40 were rejected under 35 U.S.C. §103(a) as unpatentable over Kenji in view of Limon, Jr. et al. (U.S. Patent No. 6,453,435, herein "Limon").

Claim 47 is amended to correct an informality.

With regard to the objection to the specification and claims, the specification and Claim 23 are amended to replace "recombinable" with "recomposable." Accordingly, the objection to the specification and Claim 23 is believed to be overcome.

With respect to the rejection of Claims 9, 11, 14, 16, 17, 19, 23, 32, 33, 41, 46, and 47 under 35 U.S.C. §112, second paragraph, it is again respectfully submitted that the use of the word "type" as a *noun* is *not* indefinite. The use of "type" as an *adjective* is proscribed by case law, as discussed in MPEP §2173.05(b). Accordingly, the use of "type" in Claims 9, 11,

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14, 16, 23, 32, 33, and 41 is believed to be in compliance with all requirements under 35 U.S.C. §112, second paragraph.

With regard to Claims 17 and 19, Claims 17 and 19 no longer recite "only necessary information."

With regard to Claim 46, it is respectfully submitted that the use of "a specific condition" in Claim 46 is definite as the specification provides exemplary embodiments of this claim term, for example in paragraph 253 at pages 54-55 of the present specification.

Finally, Claim 47 no longer recites "chattering." Thus, Claims 9, 11, 14, 16, 17, 19, 23, 32, 33, 41, 46, and 47 are believed to be in compliance with all requirements under 35 U.S.C. §112, second paragraph.

With respect to the rejection of Claims 9-11 under 35 U.S.C. §103(a) as unpatentable over Kenji in view of Kunio and further in view of Nakamura, that rejection is respectfully traversed.

Claim 9 recites an inspecting apparatus comprising, *inter alia*:

> a displaying device configured to display a list of the circuit baseboards;
> a determining device configured to determine a type of a circuit baseboard selected from the list via the displaying device; and
> a PLD file specifying device configured to refer to the correspondence information of the registering memory and specify an applicable PLD file based upon the circuit baseboard type; and
> a loading device configured to load the PLD with the applicable PLD file.

The outstanding Office Action apparently cited paragraphs 11-17 as describing "a determining device configured to determine a type of a circuit baseboard selected from the list via the displaying device."[1] However, it is respectfully submitted that paragraphs 11-17 of Kenji do not describe the *selection of a circuit baseboard from a list*, much less "a

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[1] See the outstanding Office Action at page 4, lines 10-13.

determining device" as defined in Claim 9. As noted previously, paragraph 15 of Kenji states

that a preprogrammed input data file 22 is displayed on a screen, and the user may then input

a command to send the data to the control section 3. *Thus, there is no teaching of any kind*

in Kenji of a selection from among types of circuit baseboards. Kenji only describes a

command to send the data to control unit 3. It is further respectfully submitted that neither

Kunio nor Nakamura disclose this element either. As the cited references do not teach or

suggest each and every element of Claim 9, Claim 9 (and dependent Claims 12-16) is

patentable over the cited references. If the outstanding rejection of Claim 9 is not withdrawn,

it is respectfully requested that for the purposes of appeal the next Office Communication

allege with particularity where Kenji describes "a determining device" as defined in Claim 9

(i.e. what is the part number of the device described by Kenji).

Claims 10 and 11 recite "an ID reading device" and "an ID determination device,"

respectively. The outstanding Office Action cited paragraph 2 of Kunio as describing these

elements,[2] an also that these elements "would be obvious in Nakamura system" without citing

any portion of Nakamura to support this assertion.[3] Instead, the Office Action simply

concludes "Further ID reading and determination would be obvious."[4] However, paragraph 2

of Kunio only describes that device driver software is different for different models. Thus,

Kunio at best describes that multiple versions of device driver software may exist for

different models. Therefore, Kunio does *not* teach or suggest "an ID reading device" and "an

ID determination device" as defined in Claims 10 and 11. As a *prima facie* case of

obviousness requires that *each and every element of the claim be taught or suggested by one*

of the cited references, it is respectfully submitted that *prima facie* case of obviousness has

not been made with respect to Claims 10 and 11 (and dependent Claims 12-16).

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[2]See the outstanding Office Action at page 4, line 17 to page 5, line 1.
[3]See the outstanding Office Action at page 5, lines 14-16.
[4]See the outstanding Office Action at page 15, line 20.

Accordingly, it is respectfully requested that the present rejection be withdrawn. If the outstanding rejection of Claims 10 and 11 are not withdrawn, it is respectfully requested that for the purposes of appeal the next Office Communication provide the part number of the device described by Kunio or Nakamura that is alleged to be "an ID reading device" and "an ID determination device" as defined in Claims 10 and 11.

Further, with regard to the rejection of Claim 15 as unpatentable over Kenji in view of Kunio and further in view of Grey, it is noted that Claim 15 is dependent from Claim 14, and thus is believed to be patentable for the reasons discussed above. Further, it is respectfully submitted that Grey does not cure any of the above-noted deficiencies of Kenji and Kunio. Accordingly, it is respectfully submitted that Claim 15 is patentable over Kenji in view of Kunio and further in view of Grey.

With respect to the rejection of Claims 17-22 under 35 U.S.C. §102(e) as anticipated by Harrison, that rejection is respectfully traversed.

Claim 17 recites a general-purpose inspecting system comprising, *inter alia*, "a sample data file generation section configured to generate a sample file having a smaller size than a size of the log file, said sample data file storing the sampled data."

The outstanding Office Action cited Figure 3 of Harrison and column 5, line 62 to column 6, line 55 of Harrison as describing this element. However, as noted previously, Harrison only describes a system for simultaneously *displaying and comparing* three original log files. There is no teaching or suggestion in any part of Harrison for *generating a sample file* having a smaller size than a size of the log file, or sampling a log file. The cited portions of Harrison only describe *scrolling through the three original log files. None* of the cited portions of Harrison describe the *creation* of any other file. Accordingly, it is respectfully submitted that Harrison does not teach "a sample data file generation section" as recited in Claim 17. As Harrison does not teach each and every element of Claim 17, Claim 17 (and

Claim 18 dependent therefrom) is not anticipated by Harrison and is patentable thereover. If the outstanding rejection of Claims 17 and 18 are not withdrawn, it is respectfully requested that for the purposes of appeal the next Office Communication provide the specific portion of Harrison that describes the creation of *any other file based on the three original log files*.

As Claim 19 recites similar elements to Claim 17, it is respectfully submitted that Claim 19 (and Claim 20-22 dependent therefrom) is patentable for at least the reasons described above with respect to Claim 17.

With respect to the rejection of Claims 23, 33, and 41-47 under 35 U.S.C. §102(a) as anticipated by Kenji, that rejection is respectfully traversed.

Claim 23 recites a general-purpose inspecting system comprising, *inter alia*:

> a software recomposing section configured to
> recompose a software of inspection use in accordance with a
> type of the object; and
> means for reading inspection progress information
> related to the object during simulation, said means for reading
> displays a resultant on a screen of a display unit.

The outstanding Office Action cited the phrase of Kenji stating "the test modification of small-scale reconstruction of software or a control unit" as describing "a software recombining section" as defined in Claim 23.[5] However, well settled case low holds that for a proper anticipation rejection "The identical invention must be shown *in as complete detail as is contained in the ... claim*." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (Emphasis added.) See also MPEP §2131. In the present case, it is respectfully submitted that the recitation of "the test modification of small-scale reconstruction of software or a control unit" in Kenji does not teach "a software recombining section configured to recombine a software of inspection use in accordance with a type of the object," as recited in Claim 23.

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[5]See the outstanding Office Action at page 7, lines 23-25.

The outstanding Office Action cited paragraphs 6 and 12 of Kenji as describing "means for reading inspection progress information" as defined in Claim 23.[6] However, the sending of data to an output file in paragraph 12 of Kenji does *not* describe *displaying a resultant on a screen of a display unit*. As previously noted, paragraph 12 of Kenji does *not* describe the displaying *anything* on a screen. Thus, it is respectfully submitted that Kenji does not teach "means for reading inspection progress information," as recited in Claim 23. As Kenji does not teach each and every element of Claim 23, Claim 23 is not anticipated by Kenji and is patentable thereover.

As Claims 33 and 41 recites similar features to those of Claim 23 in method form, it is respectfully submitted that Claims 33 and 41 is patentable for at least the reasons described above with respect to Claim 23.

Claim 42 recites a general purpose inspecting system comprising, *inter alia*, "means for determining in advance to transmission of the prescribed command whether an execution result of command processing will be abnormal by accessing the interface section and acquiring information of status of the controlled device."

The outstanding Office Action asserted that Kenji inherently discloses this feature,[7] but again, contrary to well settled case law, failed to provide any evidence to support this assertion.[8] As previously noted, "To establish inherency, *the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill*. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (Emphasis added.).

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[6]See the outstanding Office Action at page 7, line 26 to page 8, line 3.
[7]See the outstanding Office Action at page 5, lines 14-15.
[8]See the outstanding Office Action at page 4, lines 7-10.

In the present case, *no evidence of any kind* has been provided to establish that "means for determining *in advance to transmission of the prescribed command whether an execution result of command processing will be abnormal* by accessing the interface section and acquiring information of status of the controlled device" is inherent in the disclosure of Kenji. Thus, Claim 42 is not inherently described by Kenji. Accordingly, it is respectfully submitted that Kenji does not teach or suggest, either explicitly or inherently, "means for determining" as recited in Claim 42. As Kenji does not teach each and every element of Claim 42, Claim 42 (and Claims 43 and 44 dependent therefrom) is not anticipated by Kenji and is patentable thereover.

Claim 45 recites in part, "generating a second thread before entering a wait state" and "specializing said second thread to indicate a status of the controlled device on a user interface." Claim 46 recites in part, "determining if a specific condition is satisfied in the controlled device," and "automatically executing specific processing by said control processor when the specific condition is satisfied." Claim 47 recites in part, "determining if a transient phenomenon occurs when a controlled device transmits acknowledge," "repeatedly transmitting the prescribed command until the transient phenomenon is terminated from said controlled device," and "awaiting user input after termination of the transient phenomenon."

The outstanding Office Action cited paragraph 11 of Kenji as describing all of these elements.[9] However, as previously noted, the cited portion of paragraph 11 of Kenji, which states "equipment 21 might be connected and informational transmission and reception could be performed to the control section 3 or a processor," only broadly describes that information can be exchanged between equipment 21 and control section 3 or a processor. The information exchanged is not explicitly identified by Kenji. As noted above, well settled case low holds that for a proper anticipation rejection the identical invention must be shown *in as*

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[9]See the outstanding Office Action at page 10, lines 11-13, page 11, lines 11-14, and page 12, lines 15-20.

complete detail as is contained in the claim. See also MPEP §2131. In this case, <u>Kenji</u> does

not describe the above quoted elements in the detail contained in Claims 45-47, as <u>Kenji</u> only

vaguely describes communication of (unspecified) information. Accordingly, as paragraph

11 of <u>Kenji</u> does not describe "generating a second thread before entering a wait state,"

"specializing said second thread to indicate a status of the controlled device on a user

interface," "determining if a specific condition is satisfied in the controlled device,"

"automatically executing specific processing by said control processor when the specific

condition is satisfied," "determining if a transient phenomenon occurs when a controlled

device transmits acknowledge," "repeatedly transmitting the prescribed command until the

transient phenomenon is terminated from said controlled device," or "awaiting user input

after termination of the transient phenomenon," Claims 45-47 are not anticipated by <u>Kenji</u>

and are patentable thereover. If the outstanding rejection of Claims 45-47 are not withdrawn,

it is respectfully requested that for the purposes of appeal the next Office Communication

provide an explanation of how the cited sentence of <u>Kenji</u> provides all of the detail required

by each of the above-quoted elements of Claims 45-47.

With regard to the rejection of Claims 24-31 as unpatentable over <u>Kenji</u> in view of

<u>Limon</u>, it is noted that Claims 24-31 are dependent from Claim 23, and thus are believed to

be patentable for at least the reasons discussed above with respect to Claim 23. Further, it is

respectfully submitted that <u>Limon</u> does not cure any of the above-noted deficiencies of <u>Kenji</u>.

Accordingly, it is respectfully submitted that Claims 24-31 are patentable over <u>Kenji</u> in view
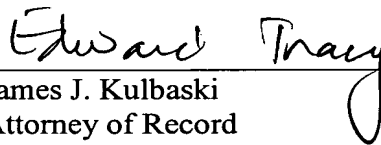
of <u>Limon</u>.

With respect to the rejection of Claim 32 under 35 U.S.C. §103(a) as unpatentable

over <u>Kenji</u> in view of <u>Limon</u>, Claim 32 recites similar elements to Claims 23 and 24. It is

respectfully submitted that the description in paragraph 9 of <u>Kenji</u> that "the test modification

of small-scale reconstruction of software or a control unit" does not provide any details

regarding "recombining an inspection software based on a type of the object" as recited in

Claim 32. Further, the sending of data to an output file in paragraph 12 of <u>Kenji</u> does not

describe "displaying respective inspection items to be inspected on a screen in order of

execution," as recited in Claim 32. In fact paragraph 12 of <u>Kenji</u>, cited on page 16, lines 16-

17 of the outstanding Office Action as describing this element, does not describe the

displaying anything on a screen. Furthermore, it is respectfully submitted that <u>Limon</u> does

not cure any of these deficiencies of <u>Kenji</u>. Consequently, Claim 32 is patentable over <u>Kenji</u>

in view of <u>Limon</u>.

Accordingly, in view of the present amendment, no further issues are believed to be

outstanding and the present application is believed to be in condition for formal allowance.

An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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